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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/607,890 | 06/30/2000 | Klaus T. Reichel | 4100-194 | 1213 |

7590

11/21/2002

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EXAMINER

WILLIAMS, KEVIN D

ART UNIT PAPER NUMBER

2854

DATE MAILED: 11/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/607,890

Applicant(s)

REICHEL, KLAUS T.

Examiner

Kevin D. Williams

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7,8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,8 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 7, 8, and 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5, 7, and 8 are inconsistent with claim 1. Claim 1 recites "only the barrel being made of a metallic material..." Claims 5, 7, and 8 recite the limitations claiming that the entire cylinder is made from the material. If "only" the barrel is made of the metallic material, as recited in claim 1, then the other parts of the cylinder "can not" be made of the metallic material.

Claims 10-12 only recite limitations that are claimed in claim 1 and therefore do not limit claim 1. A dependent claim must limit the scope of the claim from which it depends.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Gomi (US 5,061,533).

Gomi teaches a cylinder comprising a body having a barrel B as a centerpiece and two journals, a respective one of the journals being on each end of the barrel, only the barrel being made of a metallic material having a linear coefficient of expansion of about $\alpha < 1.5 \times 10^{-6} \text{ K}^{-1}$ in a temperature range of from 20° to about 60° (col. 7, lines 55-61).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda (US 5,740,736) in view of Ghosh (US 5,925,496) and Applicant's admitted prior art (AAPA).

Toyoda teaches a printing unit cylinder comprising a body having a barrel 1 as a centerpiece and two journals (Fig. 1), a respective one of the journals being on each side of the barrel. Toyoda also discusses the problems that arise from thermal expansion of the barrel (col. 1, lines 35-38). Toyoda does not provide a discussion of the particular material from which the cylinder is made and therefore does not disclose

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only the barrel being made of a metallic material having a linear coefficient of expansion of about $\alpha < 1.5 \times 10^{-6} \text{ K}^{-1}$ in a temperature range of from 20° to about 60°. Toyoda also does not disclose an iron alloy having about 36% nickel by weight.

Ghosh teaches several metallic materials that are advantageous in producing printing cylinders and that the cylinder can be composed of one or more of the metals including iron and nickel (col. 7, lines 57-61).

Applicant's admitted prior art (pg. 7, lines 1-14) discloses a known metallic material comprising iron and nickel that comprises an iron alloy having about 36% nickel by weight and having a linear coefficient of expansion of about $\alpha < 1.5 \times 10^{-6} \text{ K}^{-1}$ in a temperature range of from 20° to about 60°.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Toyoda in view of Ghosh and AAPA to have only the barrel of Toyoda be made of the material disclosed in AAPA, in order to avoid exceedingly high printing pressures as discussed by Toyoda.

Response to Arguments

6. Applicant's arguments with respect to claims 1-5, 7, 8, and 10-12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin D. Williams whose telephone number is (703)


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305-3036. The examiner can normally be reached on Monday - Friday, 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (703) 305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-4399 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

KDW
November 16, 2002


ANDREW H. HIRSHFELD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800